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Laura A. Donnelly  
Senior Patent Counsel  
Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, N.J. 08933

In re Application of	:	
Stefan Leo Jozef MASURE et al.	:	
Application No.: 09/869,079	:	
PCT Application No.: PCT/GB99/04311	:	DECISION ON
International Filing Date: 17 December 1999	:	
Priority Date: 22 December 1998	:	PETITION
Attorney Docket No.: JAB-1458	:	
For: HUMAN AKT-3	:	UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (USPTO) on 05 January 2004 is **DISMISSED**.

### **BACKGROUND**

On 05 December 2001, the USPTO, in the capacity as Designated/Elected Office, mailed out a DO/EO/905 Form ("Notification of Missing Requirements Under 35 U.S.C. 371") for this application. The DO/EO/905 Form stated that the biochemical "Sequence Listing" did not comply with the requirements of 37 CFR 1.822 and/or 1.832. The Form further stated that applicants were required to provide a substitute paper copy of the "Sequence Listing" and an amendment directing its entry into the specification.

On 15 April 2002, Applicant timely (with a three-month extension of time) filed a Response to the DO/EO/905 Form. The Response included a substitute "Sequence Listing" in paper and computer-readable form and an amendment directing entry of the substitute paper "Sequence Listing" into the specification.

On 11 June 2002, the USPTO mailed out a DO/EO/903 Form ("Notice of Acceptance of Application under 35 U.S.C. 371"). However, on 05 December 2002, the USPTO mailed out a communication stating that the DO/EO/903 Form was sent in error and had been withdrawn. The communication was accompanied by a DO/EO/916 Form ("Notification of Defective Response"). The DO/EO/916 Form stated a problem with the "Sequence Listing" and further stated that applicant must provide a substitute copy of the sequence listing and an amendment directing its entry into the specification. The Form set a non-extendable one month period for reply. Therefore applicant was required to send a proper reply that was received by 05 January 2003 in

order to prevent the application from being abandoned.

On 04 December 2003, the USPTO mailed out a DO/EO/909 Form ("Notice of Abandonment"). The DO/EO/909 Form stated that the application is abandoned as to the United States of America because applicant failed to respond to the 05 December 2002 Notification of Defective Response.

On 05 January 2004, the USPTO received a faxed communication from applicant. The unsigned cover page of the faxed communication states that the papers the follow are copies of papers that were deposited with the U.S. Post Office on September 30, 2003. The cover page further states that a copy of a date stamped postcard, dated October 3, 2003, accompanies the papers. In addition, the cover page states, "Not included is a computer copy of the Sequence Listing for obvious reasons." The papers that follow the cover page include, *inter alia*, the petition to revive and a "Response to the Notice of Defective Response" that includes an amendment and a substitute paper copy of the "Sequence Listing." A copy of a postcard receipt inventorying these items is included. However, the copy of the postcard receipt does not bear an official USPTO date stamp.

### DISCUSSION

The petition under 37 CFR 1.137(b) faxed to the USPTO on 05 January 2004 will be treated as having been filed for the first time on that date. It will not be treated as having first been filed on 03 October 2003. The cover page of the faxed communication, which appears to request relief under 37 CFR 1.181 for an earlier filing date based upon postcard evidence, is not signed by a registered practitioner, and therefore that paper cannot be treated on the merits. *See* 37 CFR 1.33. In addition, it is noted that the copy of the postcard receipt that is included in the faxed transmission does not bear an official USPTO date stamp. Therefore, it cannot serve as *prima facie* evidence of the date of original submission of the papers. *See* MPEP § 503.

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proper reply, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to 08 June 1995). A proper reply in this case requires a reply that is fully responsive to the 05 December 2002 Notification of Defective Response.

Applicant has met the first and fourth requirements of 37 CFR 1.137(b). Applicant has stated, "The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." A terminal disclaimer is not required because the application was filed on or after 08 June 1995.

With respect to the petition fee, the petition to revive includes an authorization to deduct \$110.00 dollars from the deposit account of Applicant's representative. This amount is not sufficient. The petition fee set forth in 37 CFR 1.17(m) for an entity that does not or cannot claim small entity status is \$1,330.00. However, the petition also includes authorization to deduct the deposit account for any additional fee. Therefore, the deposit account has been charged an additional \$1220.00. Accordingly, the applicant has met the third requirement of 37 CFR 1.137(b).

However, the petition cannot be granted because applicant fails to meet the second requirement of 37 CFR 1.137(b). The first reason why the reply is deficient is that it does not include a computer-readable copy of the latest substitute Sequence Listing. 37 CFR 1.825(b) states, "Any amendment to the paper copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (§ 1.821(e)) . . . ." The cover page of the faxed communication explicitly states that a computer-readable copy is not being submitted "for obvious reasons." There is no record that a computer-readable copy was submitted on 03 October 2003 and Applicant has not presented *prima facie* evidence that a copy was filed on that date. Even if such evidence was submitted, a replacement computer-readable copy is still required for processing purposes.

The reply is further deficient because it does not address all of the problems identified on the 05 December 2002 Notification of Defective Response and the attachments that were sent along with the Notification. In particular the Comment Sheet from Technology Center 1600 that was attached to the Notification indicates that there are nucleotide sequences in lines 6-8 and lines 12-14 on page 25 of the specification that are not included in the Sequence Listing. The amendment submitted on 05 January 2004 includes a replacement paragraph for the paragraph that begins on line 2 of page 25. This replacement paragraph provides "SEQ ID Nos." for the sequences that are in lines 6-8 of page 25 (lines 4-6 of the replacement paragraph, where the paragraph heading is line 1), but does not provide "SEQ ID Nos." for the two sequences that are listed in lines 12-14 of page 25 (lines 8-10 of the replacement paragraph). The "Remarks" section of the amendment does not provide a reason why these two sequences are not added to the Sequence Listing. Because both of these sequences are longer than ten nucleotides, applicant must include them in the Sequence Listing. See 37 CFR 1.821(a) & 1.821(c). Similarly, applicant must also include in the Sequence Listing the amino acid sequence in line 36 on page 20 of the current specification. This sequence is also listed on the aforementioned Comment Sheet. The replacement paragraph in the 05 January 2004 amendment for the paragraph beginning on line 16 of page 19 does not provide a "SEQ ID No." for this sequence.

### **CONCLUSION**

The petition under 37 CFR 1.137(b) to revive the application abandoned as to the National Stage in the United States of America is **DISMISSED**.

Applicant may file a request for reconsideration of this decision within a time period of **TWO (2) MONTHS** from the mailing date of this decision. *See* 37 C.F.R. 1.137(e). Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.137(b)." No additional petition fee is required for reconsideration. This time period may be extended under 37 C.F.R. 1.136(a). A request for reconsideration should be mailed to:

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 223130-1450

The contents of the letter should be marked to the attention of the Office of PCT Legal administration.



Boris Milef  
PCT Legal Examiner  
PCT Legal Administration



Ankur Parekh  
Detailee  
PCT Legal Administration

Telephone: (703) 308-1315  
Facsimile: (703) 308-6459